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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,231	03/09/2004	Marc Husemann	tesa 1649-WCG	2181
27386 7590 10/11/2007 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			EXAMINER WYROZEBSKI LEE, KATARZYNA I	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 10/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/796,231

Applicant(s)

HUSEMANN ET AL.

Examiner

Katarzyna Wyrozebski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

In view of applicant's response and amendment dated 8/7/2007 following office action is final. The applicants have amended the claims to contain at least one flame retardant consisting essentially of an ammonium polyphosphate. Examiner's response can be found after the rejections. Since the amendment does not place the application in condition for allowance, the rejections of record as stated in office action dated April 20, 2007, are incorporated here by reference.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants' new recitation of "at least one flame retardant consisting essentially of ammonium polyphosphate" is viewed as new matter for following reasons.

Applicants teach use of ammonium polyphosphate as disclosed in examples and specification. However, term "at least one" allows use of more than one ammonium

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polyphosphates. None of the examples or nowhere in specification the applicants enable use of two or more ammonium polyphosphates.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-4, 6-8, 10-13, 18-27, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by PARSONS (US 5,851,663).

The discussion of the disclosure of the prior art of PARSONS from paragraph 2 of the office action dated 4/20/2007 is incorporated here by reference.

5. Claims 1-3, 5-15, 19, 21-29 are rejected under 35 U.S.C. 102(a or e) as being anticipated by SAKURAI (US 6,893,583) in view of evidence provided in US 6,488,958 to HIMMELSBACH.

The discussion of the disclosure of SAKURAI and evidence of HIMMELSBACH from paragraph 3 of the office action dated 4/20/2007 is incorporated here by reference.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over PARSONS (US 5,851,663) or SAKURAI (US 6,893,583, or US 2002/0193487) either one of which in view of NISHIMURA (US 2005/00227065).

The discussion of the disclosure of the prior art of PARSONS or SAKURAI in view of NISHIMURA from paragraph 4 of the office action dated 4/20/2007 is incorporated here by reference.

***Response to the Applicant's Arguments***

a) Applicants arguments with respect to the prior art of PARSONS rely on the amendment and the recitation of flame retardant consisting essentially of ammonium polyphosphate.

The amendment submitted by the applicants has not obviated the prior art of PARSONS for the following reasons:

1) Although the applicants inserted limitation "consisting essentially of" with respect to the flame retardant, the entire claim contains term "comprising". The claim in itself is open to everything that is suitable for flame retardant adhesive.

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2) Term “consisting essentially of” excludes from the scope of the claim components that would chemically affect the composition. Examples include curing agents. The components that do not chemically affect the composition are still encompassed by the scope of the term “consisting essentially of”.

3) Although the prior art of PARSONS includes additional nitrogen containing flame retardant, such flame retardant does not chemically affect the composition. The composition of PARSONS still retains its flame retardant properties. In addition term “comprising” in the preamble of the claims allows for additional components such as additional flame retardants.

4) New amendment renders claims confusing. The claim reads at least one flame retardant consisting essentially of ammonium polyphosphate. This limitation incorporates further new matter, because term “at least one” allows for use of more than one ammonium polyphosphate compounds. Applicants have only support for using only one ammonium phosphate in the composition (see examples of the present invention). The applicants also did not indicate that a mixture of ammonium polyphosphates could be utilized.

b) The applicants also argued that the prior art of PARSONS does not teach acrylate adhesive (bolded) with ammonium polyphosphate and tackifying resins.

Since the applicants have bolded term “acrylate adhesive”, the examiner assumes that the applicants could not find support in PARSONS for acrylate adhesive. In such case the applicants are requested to turn to col. 4, lines 37-51, where it is indicated that the adhesive of PARSONS is acrylic adhesive.

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c) The resins that the examiner refers to in col. 5 of SAKURAI are elastomers and not tackifying resins, used to improve impact resistance.

That is correct. Elastomers are known to improve impact resistance of the polymeric compositions, however the examiner has not referred to them as resins. The examiner has simply indicated that they are there, for whatever reason. The applicants are requested not to misconstrue examiner's statements.

d) The tackifying compounds of SAKURAI are not resins.

With respect to the above argument the applicants listed paraffin, waxes and lanolin. The applicants omitted microcrystalline wax, which is branched paraffin (see Hawley's Condensed Chemical Dictionary for definition of microcrystalline wax). Branched means polymerized therefore it satisfies the definition of resin. The prior art of HIMMELSBACH further clarifies issue and indicates hydrocarbon resins as functional equivalent. In addition, claim 1 is not specific with respect to the definition of tackifying resin.

With respect to the applicant's claim 5, average molecular weight that the applicants are referring to, is this weight average molecular weight or number average molecular weight? Applicants are requested to comment and amend the claim.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

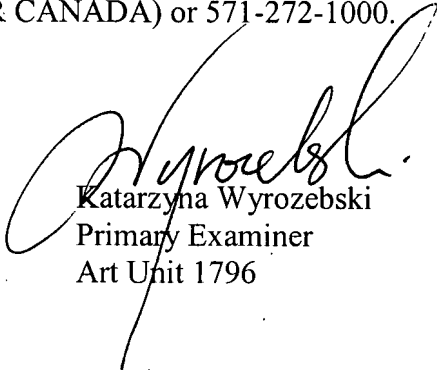
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 8:30 AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Katarzyna Wyrozebski  
Primary Examiner  
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October 2, 2007